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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/299,502 04/26/99 GAUTHIER

F 490334-00202

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WM31/1122

EXAMINER

DAVID A MANCINO
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DAYTON OH 45401-8801

GARCIA, G	
ART UNIT	PAPER NUMBER

2624

DATE MAILED:

11/22/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/299,502

Applicant(s)
Gauthler

Examiner
G. Garcia

Group Art Unit
2624



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-10 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Part III DETAILED ACTION

1. This application has been examined, Claims 1-10 are pending in this application.

2. Applicant should update the serial number information with respect to the cross reference made to the U.S. application recited on page 1 of the specification.

Double Patenting

3. The claims 1-10 are rejected under the judicially created doctrine of the obviousness type double patenting of the claims in applicant's prior United States Patent No. 5,937,153. Although the designs are not identical, they are not patentably distinct from each other because both the pending application and the Application No. 09/299,502. Claims are directed to the same invention. (e.g. claim 1 from the application teaches generating (or providing) page description code specification, interpreting and identifying the PDL, storing the character bitmap (or graphics, retrieving the variable data, associating (or linking) the variable data, generating the variable data, and repeating the steps above, these steps are describe in the steps of claims 1 and 2 of US patent No. 5,937,153. The obviousness type double patenting rejection is a judicially established doctrine based on public policy, and is primarily intended to prevent prolongation

of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent.

A timely filed terminal disclaimer will obviate this rejection. (MPEP... § 1490) *In re Vogel*, 164 USPQ 619 (CCPA 1970).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Norton (6,016,380) teaches a template based edit decision list management system.

Gauthier (5,937,153) teaches a method for utilizing variable data fields with a page description language.

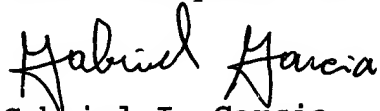
Gauthier (5,740,338) teaches a method for merging variable image data into a template image.

Young (5,852,673) teaches a method for general image manipulation and composition.

Gauthier (5,729,665) teaches a method of utilizing variable data fields with a page description language.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone numbers for official faxes for this group is (703) 308-9051 or 308-9052, and the fax number for informal or drafts is (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700 or 4750.

A handwritten signature in black ink that reads "Gabriel Garcia". The signature is written in a cursive, flowing style.

Gabriel I. Garcia
Patent Examiner
November 17, 2000